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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,100	04/07/2004	James N. Vinci	2926B/R-02	9503

7590
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EXAMINER

TOOMER, CEPHIA D

ART UNIT	PAPER NUMBER
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1714

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/09/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/820,100

Applicant(s)

VINCI, JAMES N.

Examiner

Cephia D. Toomer

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,6,8-11 and 17-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3,6,8-11 and 17-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

DETAILED ACTION

Specification

1. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Objections

2. Claims 1 and 10 are objected to because of the following informalities: Claims 1 and 10 should be amended to read – a friction modifier selected from a glycerol ester or a borated glycerol ester--.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 10, 17 and their dependents are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The formula for the hydrocarbyl phosphite is incorrect.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 1714

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-3, 6, 8,10,11 and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ichihashi (US 5,792,731) in view of Nibert (US 5,750,476).

Ichihashi teaches a lubricant composition for transmissions comprising a phosphorus-based extreme pressure agent and an alkaline earth metal-based detergent (see abstract).

The phosphorus-based compound may be a phosphite of the formula $(RO)_3P$ wherein R is a C_3 - C_{30} alkyl or C_6 - C_{30} aryl (see col. 3, line 55 through col. 4, lines 1-20). The phosphite is present in the composition in an amount from 0.05-5 wt.% (see col. 4, lines 64-67).

The alkaline earth metal-based detergent may be a carboxylic acid acylating agent such as, a sulfonate or salicylate (see col. 5, lines 4-11). The TBN of the detergent is in the range of 80-350 mg KOH/g. The detergent is present in the composition in an amount from 0.05 - 8 wt% (see col. 5, lines 4-25). The composition of Ichihashi meets the limitations of the claims regarding the ratio of equivalents because the equivalents of the overbased material is for 160-701 and the equivalents of the phosphite is such that the ratio of overbased material to phosphite is at least one.

Applicant's intended use is given no patentable weight because intended use is given no patentable when the claims are directed to the composition per se.

Ichihashi teaches the limitations of the claims other than that a friction modifier is present in the composition and that the friction modifier is a glycerol ester or a borated glycerol ester. However, Nibert teaches this difference.

Nibert teaches a lubricant for transmission fluids comprising oil-soluble phosphorus containing compounds, overbased metallic salts and polyol esters such as glycerol mono-oleate (see abstract; col. 7, lines 35-65; col. 8, lines 40-45; col. 9, lines 22-28). The polyol ester friction modifiers may be used in an amount from 0.01 to 10 wt% of the finished lubricant (see col. 9, lines 29-33).

It would have been obvious to one of ordinary skill in the art to include a glycerol ester friction modifier because Ichihashi teaches that his transmission composition, containing compounds similar to those set forth in Nibert, is capable of transmitting a large amount of torque (see col. 1, lines 37-52) and Nibert teaches transmission fluids such as those used in Ichihashi must have a very good friction versus velocity relationship, therefore, the addition of friction modifiers such as glycerol esters imparts this desired property.

7. Applicant's arguments filed April 7, 2004 have been fully considered but they are not persuasive.

Applicant argues that Ichihashi does not anticipate the claimed friction modifiers.


The Ichihashi reference has been combined with a secondary reference, Nibert, to teach this limitation. Nibert teaches the desirability of adding a friction modifier.

The 103 rejection over Hollinghurst in view of Ohtani is not presented in this Office action. Therefore, all arguments directed to that rejection are moot.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cephia D. Toomer whose telephone number is 571-272-1126. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Cephia D. Toomer
Primary Examiner
Art Unit 1714